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REMARKS

Claim 30 has been amended to now recite "wherein capture molecules are located on areas of said disc that do not comprise registered data". No new matter has been introduced by this amendment. The following addresses the substance of the Office Action.

The Examiner has rejected Claims 30, 31, 34, 40, 41, 45 and 64 under 35 USC §102(e) as allegedly anticipated by or, in the alternative, under 35 USC §103(a) as allegedly obvious over US 2002/0058242A1 (Demers).

Applicant respectfully submits that the Demers reference does not constitute prior art under 35 USC §102(e) with respect to the present application. The Demers reference is a US application publication of a US National Phase application No.: 09/269,092 based on the international application PCT/US97/16738 filed September 19, 1997.

According to MPEP 2136:

The revised statutory provisions *>supersede< all previous versions of 35 U.S.C. 102(e) and 374, with only one exception, which is when the potential reference is based on an international application filed prior to November 29, 2000. As mentioned above, references based on international applications that were filed prior to November 29, 2000 are subject to the former (pre-AIPA) version of 35 U.S.C. 102(e) as set forth below.

Former 35 U.S.C. 102 Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless-

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.
(emphasis added)

Since the PCT application which gave rise to the Demers publication was filed prior to November 29, 2000, the 102(e) date of the publication is determined under the pre-AIPA version of 35 USC 102(e). Consequently, the 102(e) date of the Demers reference is determined by the date that the requirements of paragraphs (1), (2), and 94) of section 371 are fulfilled.

The fact that the 102(e) date of the U.S. National Phase of an international application claiming priority to a U.S. provisional application is the date that the requirements of paragraphs (1), (2), and 94) of section 371 are fulfilled is further illustrated in **MPEP 2136.03(III)**.

The 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications and certain international application publications entitled to the benefit of the filing

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date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application with certain exceptions >if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph<. See MPEP § 706.02(f)(1), examples 5 to 9. Note that international applications which (1) were filed prior to November 29, 2000, or (2) did not designate the U.S., or (3) were not published in English under PCT Article 21(2) by WIPO, may not be used to reach back (bridge) to an earlier filing date through a priority or benefit claim for prior art purposes under 35 U.S.C. 102(e).

In addition, Example 6 of **MPEP 706.02(f)(1)** further demonstrates that the 102(e) date of the Demers application is the date the requirements of paragraphs (1), (2), and 94) of section 371 are fulfilled. (Note the section entitled "Additional Priority/Benefit Claims" at the end of Example 6).

Finally, the Notification of Acceptance of Application under 35 USC 371 for the Demers application (copy obtained from Public PAIR is submitted herewith), indicates that the 102(e) date of the Demers US 09/269,092 application is March 18, 1999, which is AFTER the priority date of the present application of December 30, 1997.

Finally, the pre-AIPA version of 35 U.S.C. §102(e) requires that a patent must issue on the cited application. The Demers application has not issued as a patent.

For the foregoing reasons, the cited Demers US 2002/0058242A1 application publication is not prior art under 35 U.S.C. §102(e) against the present application, and the rejection of all claims under 35 USC 102(e) or 103(a) should be withdrawn.

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CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, Applicants request the expeditious allowance of the pending claims.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call the undersigned to discuss such issues.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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